

REMARKS / ARGUMENTS**I. General Remarks and Disposition of the Claims**

Please consider the application in view of the following remarks. Applicants thank the Examiner for his careful consideration of this application., including the references Applicants have submitted in this application and, pursuant to Manual of Patent Examining Procedure (MPEP) § 609.02, all references submitted in the patent application to which this application claims priority under 35 U.S.C. § 120.

At the time of the Final Office Action, claims 1-38 were pending in this application. Claims 7 and 11-38 were withdrawn from consideration. Claims 1-6 and 8-10 were rejected in the Final Office Action. Applicants respectfully request reconsideration in light of the remarks contained herein.

II. Remarks Regarding Rejection Under 35 U.S.C. § 102

Claims 1-6 and 8-10 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent Application Publication No. 2003/0013871 to Mallon *et al.* (hereinafter "*Mallon*"). With respect to this rejection, the Final Office Action states:

Applicant's arguments in Response with respect to the 35 U.S.C. 102(b) rejection of claims 1-6 and 8-10 as anticipated by Mallon have been fully considered but deemed unpersuasive.

Applicant's primary argument in Response traversing the captioned rejection is that Mallon does not disclose the alkyl side chain of its polymer having the same number of carbons as the polymer of the present invention. Particularly, Applicant states:

"... [W]ith respect to independent claim 1, Mallon fails to disclose "a water-soluble relative permeability modifier that comprises a hydrophobically modified polymer." Although *Mallon may disclose reacting chitosan with a salt having up to three carbons*, Mallon fails to disclose a "hydrophobically modified" polymer as defined by Applicants . . . *Applicants have defined "hydrophobically modified" to refer to the incorporation into the hydrophilic polymer structure of hydrophobic groups, wherein the alkyl chain length is from about 4 to about 22 carbons.* (See Specification, ¶ [0018]) . . . As *the . . . hydrophobic compounds of Mallon comprise up to three carbons*, their incorporation into a hydrophilic polymer would not constitute hydrophobic

modification. See Mallon, ¶ [0018] . . . Therefore, Applicants respectfully submit that Mallon fails to disclose a water-soluble relative permeability modifier that comprises a hydrophobically modified polymer. As such, the cited reference does not anticipate this claim.” [Emphasis added by Examiner.]

That is, Applicant alleges that the polymer disclosed in Mallon does not anticipate the polymer component of the relative permeability modifier recited in independent claim 1 because its alkyl chain has 3 carbons whereas that of the present invention has “about 4 to about 22 carbons” (as defined in the cited paragraph of the present specification and recited in instant claim 8). This argument has been determined unpersuasive because the first endpoint of the recited range disclosed in the specification cited by Applicant (“about 4 carbons”) must encompass an alkyl chain having three carbons. Because a range of carbons numbers for an alkyl chain must all be integers (a side chain can not contain an alkyl chain having a length of, for example, 3 and a half carbons), the term “about” implies that three carbons may anticipate this range limitation of the claim. Otherwise, the term “about” in the present claims would be superfluous.

Moreover, *assuming arguendo*, in accordance with the doctrine of claim differentiation, dependent claim 8 would not be further limiting because it recites the same exact range of carbon numbers for the alkyl side chain that Applicant now alleges is implicit in independent claim 1.

Furthermore, as to claims 1-6, 9 and 10 specifically, it is noted that this range limitation for the alkyl chain that Applicant relies upon is not recited in these rejected claims. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 2057 (Fed. Cir. 1993).

Thus, the instant claims, as amended, remain anticipated by Mallon.

(Final Office Action at 2-4.) Applicants respectfully disagree. Applicants respectfully submit that the cited reference does not disclose each and every limitation of claims 1-6 and 8-10 as required to anticipate these claims under 35 U.S.C. § 102(b). See MPEP § 2131.

At the outset, Applicants note that while *In re Van Geuns* may state the proposition that limitations are not necessarily read into the claims from the specification, Applicants kindly refer the Examiner to MPEP § 2111.01(IV), which states:

An applicant is entitled to be his or her own lexicographer and may rebut the presumption that claim terms are to be given their ordinary and customary meaning by clearly setting forth a definition of the term that is different from its ordinary and customary meaning(s). See *In re Paulsen*, 30 F.3d 1475, 1480, 31 USPQ2d 1671, 1674 (Fed. Cir. 1994) (inventor may define specific terms used to describe invention, but must do so “with reasonable clarity, deliberateness, and precision” and, if done, must “set out his uncommon definition in some manner within the patent disclosure’ so as to give one of ordinary skill in the art notice of the change” in meaning) (quoting *Intellicall, Inc. v. Phonometrics, Inc.*, 952 F.2d 1384, 1387-88, 21 USPQ2d 1383, 1386 (Fed. Cir. 1992)). Where an explicit definition is provided by the applicant for a term, that definition will control interpretation of the term as it is used in the claim. *Toro Co. v. White Consolidated Industries Inc.*, 199 F.3d 1295, 1301, 53 USPQ2d 1065, 1069 (Fed. Cir. 1999).

MPEP § 211.02(IV). As Applicants demonstrated in their previous response, Applicants have clearly set forth a definition of the term “hydrophobically modified.” That is, Applicants have, with reasonable clarity, deliberateness, and precision, defined the term hydrophobically modified to refer “to the incorporation into the hydrophilic polymer structure of hydrophobic groups, wherein the alkyl chain length is from about 4 to about 22 carbons.” (See Specification, ¶ [0018].) Thus, this explicit definition controls the interpretation of the term hydrophobically modified as it is used in the claims. Therefore, although the requirements that Applicants’ hydrophobically modified polymer has incorporated within its hydrophilic polymer structure a hydrophobic group, wherein the alkyl chain length is from about 4 to about 22 carbons, are not stated word-for-word in the claims, this limitation is inherently found by the use of the term hydrophobically modified. Thus, this limitation is found in the claims.

With respect to independent claim 1, *Mallon* fails to disclose “a water-soluble relative permeability modifier that comprises **a hydrophobically modified polymer.**” Specifically *Mallon* fails to disclose a hydrophobically modified polymer because *Mallon* does not disclose a hydrophilic polymer structure with hydrophobic groups, wherein the alkyl chain length is from about 4 to about 22 carbons, incorporated into the hydrophilic polymer structure. In the Final Office Action the Examiner alleges that *Mallon* discloses this requirement because the term “the alkyl chain is from about 4 to about 22 carbons” encompasses alkyl chains of 3 carbons, and that *Mallon* discloses lower carboxylates having 3 carbons (*i.e.* propionates) of lithium, niobium, calcium, magnesium, aluminum, or ammonia. (See Final Office Action at 3.)

Applicants submit that it is irrelevant whether the term “the alkyl chain is from about 4 to about 22 carbons” encompasses alkyl chains of 3 carbons, because *Mallon* still fails to disclose 3 carbon alkyl chains that are hydrophobic. See *Mallon*, ¶ [0018]. Specifically, lithium propionate, nibidium propionate, calcium propionate, magnesium propionate, aluminum propionate, and ammonia propionate are not hydrophobic. In addition to Applicants’ definition of “hydrophobically modified” requiring the incorporation of alkyl chains from about 4 to about 22 carbons in a hydrophilic polymer structure, Applicants definition also requires that these alkyl chains be a hydrophobic group. See Specification, ¶ [0018]. As the 3 carbon alkyl chains in *Mallon* are not a hydrophobic group, their incorporation into a hydrophilic polymer structure would not create a hydrophobically modified polymer.

Therefore, Applicants respectfully submit that *Mallon* fails to disclose a water-soluble relative permeability modifier that comprises a hydrophobically modified polymer. As such, the cited reference does not anticipate this claim. Therefore, Applicants respectfully assert that independent claim 1 and its dependent claims are not anticipated by *Mallon*. Accordingly, Applicants respectfully request withdrawal of this rejection with respect to claims 1-6 and 8-10.

Furthermore, with respect to the Examiner’s comment regarding claim 8, Applicants respectfully submit that claim 8 is further limiting. While independent claim 1 inherently requires that the hydrophobically modified polymer has incorporated within its hydrophilic polymer structure a hydrophobic group, wherein the alkyl chain length is from about 4 to about 22 carbons, claim 1 does not inherently require that the hydrophobically modified polymer be “a reaction product of a hydrophobic compound and a hydrophilic polymer that comprises a polymer backbone comprising polar heteroatoms” as required by claim 4. Thus, Applicants respectfully submit that dependent claim 8, which depends from claim 4, which depends from claim 1, further limits independent claim 1.

III. No Waiver

All of Applicants’ arguments and amendments are without prejudice or disclaimer. Additionally, Applicants have merely discussed example distinctions from the cited references. Other distinctions may exist, and Applicants reserve the right to discuss these additional distinctions in a later Response or on Appeal, if appropriate. By not responding to additional statements made by the Examiner, Applicants do not acquiesce to the Examiner’s


additional statements, such as, for example, any statements relating to what would be obvious to a person of ordinary skill in the art.

SUMMARY

In light of the above remarks, Applicants respectfully request reconsideration and withdrawal of the outstanding rejections. Applicants further submit that the application is now in condition for allowance, and earnestly solicit timely notice of the same. Applicants respectfully request that the Examiner issue an Advisory Action if the Examiner does not find the claims to be allowable in light of the remarks made herein. Should the Examiner have any questions, comments or suggestions in furtherance of the prosecution of this application, the Examiner is invited to contact the attorney of record by telephone, facsimile, or electronic mail.

Applicants believe that no fees are due in association with the filing of this response. Should the Commissioner deem that any fees are due, including any fees for extensions of time, Applicants respectfully request that the Commissioner accept this as a Petition Therefor, and direct that any additional fees be charged to Baker Botts, L.L.P.'s Deposit Account No. 02-0383, Order Number 063718.0411.

Respectfully submitted,



Larissa Piccardo
Registration No. 60,448
BAKER BOTTS L.L.P.
One Shell Plaza
910 Louisiana
Houston, TX 77002
Telephone: 713.229.1465
Facsimile: 713.229.7765
Email: larissa.piccardo@bakerbotts.com

Date: February 23, 2009